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PATENT
Attorney Docket No.: 10517-37US

Al. Beelone

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Volker Schmidt

Application No.: 08/836,369

Filed: May 13, 1997

For: TEMPERATURE-MEASUREMENT
INSTRUMENT WITH DIFFRACTIVE
OPTICS

**ATTENTION: LICENSING AND
REVIEW BRANCH**

Examiner: A. Hirshfield

Art Unit: 2859

PETITION FOR A RETROACTIVE
FOREIGN FILING LICENSE AND
AUTHORIZATION TO CHARGE
DEPOSIT ACCOUNT

RECEIVED
LICENSING & REVIEW
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Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Pursuant to 37 CFR 5.25, petitioner requests a retroactive filing license for the above-referenced subject matter. A copy of the originally-filed, referenced patent application is enclosed. This application is a copy of International Application PCT/EP96/0330, filed 29 July 1996, which is a translation of German Patent Application 195 28 590.5 filed 3 August 1995.

The subject matter of claim 1, directed to a laser sighting device for a radiometer utilizing a diffraction grating generating a plurality of dots to outline the energy zone, was conceived and reduced to practice by William Menchine, a citizen of the U.S., in Santa Cruz, CA. Accordingly, a foreign filing receipt was required prior to filing the application in Germany. As is evident from the facts set forth below, the failure to obtain a foreign filing license prior to filing the German patent application was inadvertent and without deceptive intent.

Subsequent to Mr. Menchine's original conception and reduction to practice, work began at Raytek, Santa Cruz on a project, internally named "Shark," to develop a commercial product embodying the invention. One of Mr. Menchine's goals for the

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commercial product was to accurately outline the energy zone at distances both near and far from the radiometer. The realization of this goal required development of complex new technology. Because commercial requirements required development of a new product in a short period of time, the Shark project was postponed and efforts at Raytek Santa Cruz were redirected to developing a product, designated the "3i", which used a laser sighting device including a beamsplitter and mirrors which directed two beams to identify the energy zone.

Subsequent to the postponement of the Shark project, engineers at Raytek Gmbh, Berlin, led by Volker Schmidt, developed an elegant commercial product, designated the "MX." The MX uses a diffraction grating and prism ring to form a laser dot at the center of the energy zone and a series of laser dots that outline the energy zone. The prisms in the prism ring redirect these beams so as to outline a volume that precisely defines the energy zone of the infrared optics at various distances.

Mr. Volker Schmidt, a named inventor on the present application, observed diffraction gratings at a trade show in Germany and decided to incorporate a diffraction grating into the MX. A system of prisms was used to direct rays emanating from the diffraction grating to accurately outline the energy zone at near and far distances.

It was Raytek's policy that each division was in charge of patent filing for technology developed at the division. Management at Raytek Gmbh, Berlin decided to file two German patent applications covering technology developed relating to the MX project. The first of these German patent applications was later filed as a PCT application and has subsequently entered the national stage in the U.S. as the referenced U.S. patent application S/N 08/836,369.

The German patent attorney, Dr. Michael Tetzner, was aware that the MX product had been developed at Raytek, Gmbh under the direction of Mr. Schmidt. Dr. Tetzner was informed by Mr. Schmidt that he was the sole inventor. There was no investigation concerning whether inventors working at Raytek, Santa Cruz should be named as inventors. However, claims were submitted that were broad enough to read on the conception and reduction to practice of Mr. Menchine.

Upon studying the claims of the above-referenced patent application, subsequent to entering the U.S. national stage, it was realized by patent counsel, Charles E.


Krueger and James Isbester, of Raytek Santa Cruz that some of the claims were broad enough to cover the U.S. conception and reduction to practice of Mr. Menchine. At that time, and in connection with litigation instigated by Omega Corp. alleging patent infringement by the MX, a detailed study of inventorship was instigated. This study has been diligently pursued and required interviewing personnel in California and Germany and also required the location of documents now several years old. This petition has been filed as soon as the relevant facts had been determined.

It was determined from reviewing documents that Mr. Menchine had informed Mr. Schmidt of his work regarding the use of a diffraction grating in a laser sighting device prior to Mr. Schmidt's viewing the diffraction grating at the German trade show. Files were discovered in Mr. Schmidt's possession detailing the work of Mr. Menchine and discussions with Mr. Menchine were held on the ways to improve Mr. Menchine's work to develop a product that would accurately outline the energy zone. However, at the time of filing the German patent application, about three years after the discussions in Santa Cruz, Mr. Schmidt had forgotten that he received this material regarding Mr. Menchine's work and that he had had conversations regarding the work. Thus, it was not realized that Mr. Menchine should have been named as inventor on the application or that a foreign filing license was required.

Accordingly, applicant is petitioning to obtain a retroactive foreign filing license. In view of the above, it is clear that the failure to obtain a foreign filing license prior to filing the German patent application was inadvertent and without deceptive intent.

The Commissioner is hereby authorized to charge the \$130.00 petition fee, any additional fees that may be required, or credit any overpayment to the undersigned's deposit account No. 20-1430. This petition is submitted in triplicate.

Respectfully submitted,


Charles E. Krueger
Reg. No. 30,077

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